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Dated: November 25, 2007 Signature: /Mark D. Russett/
Mark D. Russett, Reg. No. 41,281

Attorney Docket No. 56710 (70801)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Nobuyuki Takamori et al.

Application No.: 10/002,952

Confirmation No.: 5464

Filed: November 15, 2001

Art Unit: 1756

For: OPTICAL DATA RECORDING MEDIUM

Examiner: M. J. Angebranndt

Mail Stop Appeal Brief—Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

REQUEST FOR RECONSIDERATION/REHEARING OF BPAI DECISION
PURSUANT TO 37 C.F.R. §41.52

Sir:

This is a request for reconsideration/rehearing of the BPAI decision dated September 25, 2007, pursuant to 37 C.F.R. §41.52. This paper is filed within two months of the date of the BPAI decision (November 25, 2007, being a Sunday), and is therefore believed to be timely filed.

FEES

It is believed that no fee is required in connection with the filing of this request for reconsideration/rehearing. However, if for any reason a fee is required, a fee paid is inadequate or credit is owed for any excess fee paid, the Commissioner is hereby authorized and requested to charge Deposit Account No. **04-1105** under order no. 56710 (70801).

ARGUMENT

I. Introduction

On August 23, 2006, Appellants submitted their Brief on Appeal in connection with the above-referenced application. On November 14, 2006, the Examiner's Answer to that Appeal Brief was mailed from the U.S. Patent and Trademark Office. On January 16, 2007, Appellants submitted a Reply Brief. On September 25, 2007, the Board of Patent Appeals and Interferences (BPAI) issued a Decision on Appeal affirming the rejection of the pending claims. Appellants now request rehearing and/or reconsideration of the BPAI decision pursuant to 37 C.F.R. §41.52.

II. The Board Has Misapprehended or Overlooked the Differences Between the Disclosure of the Tajima Reference and the Present Claims

In the Examiner's Answer, the Examiner reiterated his view that Figure 10 of the cited Tajima reference inherently discloses a medium meeting the limitations of the pending claims. In essence, the Examiner argues that, if the medium described in Figure 10 of the Tajima reference has the disclosed value for warpage, then the expansion coefficient under humidity of that medium must meet the limitations of the present claims. See, e.g., pages 5 and 6 of the Examiner's Answer.

The BPAI has apparently adopted this view (see especially pages 5-6 of the Decision on Appeal). However, the Decision on Appeal *itself* describes **differences** between the disclosure of the Tajima reference and the subject matter of the pending claims. For example, at page 5 of the Decision on Appeal, Tajima's "Table 5 embodiment" is described as having (i) "a transparent polycarbonate layer", (ii) a "thin film layer made of aluminum nitride", (iii) a "substrate protective film" and (iv) a "thin film protection layer". In contrast, the present disclosure is stated to include (i) a transparent substrate, (ii) a "thin film layer made of aluminum nitride", and

(iii) a “protective film” (see page 6, lines 1-6 of the Decision on Appeal). The Board goes on to conclude (citing additional properties) that “there is a reasonable basis in fact for believing that Tajima’s thin film protective layer inherently possesses the claimed expansion coefficient under humidity.”

However, as described by Appellants (e.g., in the Reply Brief at pages 3-4), although the Examiner (and now the Board) states that the properties of the presently-claimed media and the media disclosed in the Tajima reference are the same, optical recording media having similar deflection values as a whole need not have identical properties, e.g., need not have identical Young’s modulus, expansion coefficient under humidity, thickness, etc. Indeed, the values of the various properties for each of the layers of materials can be varied. The issue is not whether “Tajima’s optical information recording medium inherently possesses the claimed physical properties,” BPAI Decision on Appeal at page 7, lines 8-10; rather, it is whether “each and every element as set forth in the [pending] claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

Appellants note that the present claims (see, e.g., claim 1) require that a protective film layer is “formed on the thin film layer for protecting the thin film layer.” Each of the claims additionally requires that the thin film protective film have certain properties (such as an expansion coefficient under humidity and (in some claims) Young’s modulus).

As noted above, Table 5 of Tajima discloses a four-layer structure including a substrate protective film (positioned on the side of the substrate opposite the thin film layer). As discussed in Appellants’ Appeal Brief (at page 12), the four-layer structure disclosed by Tajima (e.g., in Figure 1) is similar to a conventional medium as described for Comparative Example 1 of the present specification, which has an expansion coefficient under humidity of 6.25×10^{-5} (1%). As also noted in the Appeal Brief (e.g., at page 11), the Tajima reference is directed to optical recording media in which the warpage caused by temperature changes is reduced (see, e.g., the Abstract).

In the present case, there is no evidence that similar deflection values for the media of Tajima and the media of the present invention are due to a thin film protective film of Tajima having the properties recited for the thin film protective film and transparent substrate of the present claims. In other words, even if certain embodiments of the media disclosed in the Tajima reference have warpage angle properties similar to the claimed media, this is not evidence that the thin film protective layer of Tajima inherently must have the properties as recited in the present claims. The warpage characteristics of the Tajima media are the result of the combined properties of all the materials used in the Tajima media, not solely the result of the properties of the thin film protective film.

As noted in Appellants' Reply Brief (at page 4), to obtain a particular warpage under conditions of changing humidity may require that the protective film have different properties depending upon the properties of the substrate, e.g., Young's modulus, expansion coefficient under humidity, thickness, etc. In addition, the properties of the other materials must also be considered. Therefore, the argument urged by the Examiner (and apparently adopted by the Board) – that the warpage or change in the deflection value seen in embodiments of the present invention and in examples of the Tajima reference is evidence that the thin film protective layer of Tajima has the properties of the thin film protective layer of the presently-claimed media – is not supportable.

Because the Examiner has not shown that "the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art," MPEP 2112(IV), citing *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990), the properties of the thin film protective layer as defined by the pending claims are not inherent properties of any thin film protective layer described in Tajima. Further, because "the claimed products are not identical or substantially identical" to the disclosure of the applied reference, the holding of *In re Best* does not apply.

It follows, then, that the pending claims are not anticipated by the Tajima reference. Appellants respectfully request that the Board reconsider and reverse the decision of the Examiner and the rejection of the pending claims.

SUMMARY

Appellants request rehearing and/or reconsideration of the BPAI decision. Appellants submit that all of the claims under final rejection are in condition for allowance and should be allowed, and that the Final Office Action should be vacated.

If for any reason a fee is required, a fee paid is inadequate or credit is owed for any excess fee paid, you are hereby authorized and requested to charge Deposit Account No. **04-1105**, under Reference No. 56710 (70801), Customer No. 21874.

Respectfully submitted,

Date: November 25, 2007

By: /Mark D. Russett/
Mark D. Russett, Reg. No. 41,281
EDWARDS ANGELL PALMER & DODGE LLP
P. O. Box 55874
Boston, MA 02205
Tel. (617) 439-4444
Fax (617) 439-4170
Customer No.: 21874